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EXAMINER

DULANEY, BENJAMIN O

ART UNIT

PAPER NUMBER

2625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/057,919

Applicant(s)

TSUBAKI ET AL.

Examiner

BENJAMIN O. DULANEY

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments, filed 3/19/08, with respect to the rejection(s) of claim(s) 1-26 under 35 U.S.C. 102(e) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. patent 6,603,506 by Ogawa et al. and U.S. patent 7,034,880 by Endsley et al.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 1) Claims 1-4, 7, 8, 10, 19 and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 6,603,506 by Ogawa et al.
- 2) Regarding claim 1, Ogawa teaches a portable device, comprising: an image-capturing device which captures an image (column 7, lines 63-67); a recording device which records said captured image (column 7, lines 66-67); a service information input device which inputs, from a communication device, service information about an image service provided by said server (column 8, lines 13-27), and an information processing

device which converts said captured image to an image based on the service information (column 8, line 57-65), said image based on the service information being recorded in a recording medium and transmitted to said server via said communication device (column 8, line 66 – column 9, line 6), wherein said service information comprises information transmitted from said server to said communication device based on a user input to said communication device (Column 8, lines 5-7).

3) Regarding claim 2, Ogawa teaches the portable device according to claim 1, wherein the recording device records the service information together with the image in the recording medium (Column 8, lines 18-20; the format information is transferred to the camera and therefore must be stored).

4) Regarding claim 3, Ogawa teaches the portable device according to claim 1, wherein the input device inputs server identifying information for specifying the server together with the service information, and wherein the recording device records the server identifying information together with the image (column 8, lines 31-35; output devices and PCs can all be considered servers when sending and receiving information).

5) Regarding claim 4, Ogawa teaches the portable device according to claim 1, wherein the input device inputs service content information indicating the content of the image service, and wherein the recording device records the service content information together with the image (column 8, lines 31-35).

- 6) Regarding claim 7, Ogawa teaches the portable device according to claim 1, wherein the service information input device reads service information recorded in the recording medium and inputs service information (column 8, lines 13-27).
- 7) Regarding claim 8, Ogawa teaches the portable device according to claim 1, wherein the service information input device inputs said service information from said communication device one of wirelessly and via a wire (column 8, lines 13-27).
- 8) Regarding claim 10, Ogawa teaches the portable device according to claim 1, further comprising: a specifying device which allows a user to specify service information including a predetermined aspect ratio, the number of pixels, compressibility, or a file size within a permissible range when specification is made within the permissible range regarding service information including a predetermined aspect ratio, the number of pixels, compressibility, or a file size, wherein the recording device records an image in the recording medium according to service information specified by the user (column 8, lines 47-49; selecting an image quality is analogous to selecting the number of pixels).
- 9) Regarding claim 19, Ogawa teaches the portable device according to claim 1, wherein said image service provided by said server comprises at least one of a printing service for printing said images and a distribution service for distributing said image (column 8, lines 31-35).
- 10) Regarding claim 21, Ogawa teaches the portable device according to claim 1, wherein said service information about said image service provided by said server comprises at least one of: format of the image such as an image recording format or an

image format; an aspect ratio of the image or a permissible range of the aspect ratio; numbers of pixels in vertical and horizontal directions of the image or a permissible range of the numbers of pixels; and compressibility for compressing and recording the image, a file size of the image upon recording, or a permissible range of the compressibility or the file size (column 8, lines 31-35).

11) Regarding claim 22, Ogawa teaches the portable device according to claim 1, wherein said information processing device converts said captured image to an image based on the service information after said captured image is recorded in said recording medium by said recording device (column 7, lines 63-67; column 8, lines 57-65).

12) Regarding claim 23, Ogawa teaches a portable device, comprising: an image-capturing device which captures an image (column 7, lines 63-67); a recording device which records said captured image (column 7, lines 66-67); a service information input device which inputs, from a communication device, service information about an image service provided by said server (column 8, lines 13-27), and an information processing device which converts said captured image to an image based on the service information (column 8, line 57-65), said image based on the service information being recorded in a recording medium and transmitted to said server via said communication device (column 8, line 66 – column 9, line 6), wherein said service information comprises information transmitted from said server to said communication device based on a user input to said communication device (Column 8, lines 5-7), and wherein said portable device captures said image in an image-capturing mode suitable for an image service provided by said server (column 8, line 57-65; data was suitable for conversion

Art Unit: 2625

and therefore is suitable for the "server"/PC/output device that the image was converted for).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13) Claims 6, 12-18, 20 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,603,506 by Ogawa et al., and further in view of U.S. patent 7,034,880 by Endsley et al.

14) Regarding claim 6, Ogawa does not specifically teach the portable device according to claim 1, further comprising: an image reading device which reads an image, wherein information processing device converts an image read by the image reading device to an image based on the service information, and records the converted image in the recording medium.

Endsley teaches the portable device according to claim 1, further comprising: an image reading device which reads an image, wherein information processing device converts an image read by the image reading device to an image based on the service

information, and records the converted image in the recording medium (column 4, lines 57-60).

Ogawa and Endsley are combinable because they are both from the camera image field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Ogawa with Endsley to add storing a converted image. The motivation for doing so would have been storing an image on a camera's memory as a JPEG. Therefore it would have been obvious to combine Ogawa and Endsley to obtain the invention as specified by claim 6.

15) Regarding claims 12, 17 and 18, Ogawa teaches transmitting to said server an image recorded by a portable device onto a loadable recording medium (column 8, line 66 – column 9, line 6), a receiving device which receives, from a server, service information about said image service provided by user; a service information output device which outputs the received service information to a portable device, said image being recorded on said recording medium by a portable device based on said service information (column 8, lines 13-27), wherein said service information comprises information transmitted from said server to said mobile phone based on a user input to said mobile phone (Column 8, lines 5-7), and wherein said portable device comprises an image-capturing device which captures an image (column 7, lines 63-67), and an information processing device which converts said captured image to an image based on the service information (column 8, line 57-65).

Ogawa does not specifically teach a mobile phone which is capable of

performing voice communication, communicating information to a server for providing image service.

Endsley teaches a mobile phone which is capable of performing voice communication, communicating information to a server for providing image service (column 2, lines 11-18; column 13, lines 22-29; the camera could be attached to a cell phone; alternatively the camera could communicate with a cellular device through a portable storage medium as shown in figure 1, item 20).

Ogawa and Endsley are combinable because they are both from the camera image field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Ogawa with Endsley to add a mobile phone. The motivation for doing so would have been "so that a separate communication device is not necessary" (column 13, line 25). Therefore it would have been obvious to combine Ogawa and Endsley to obtain the invention as specified by claims 12, 17 and 18.

16) Regarding claim 13, Ogawa teaches the mobile phone according to claim 12, wherein the recording medium records server identifying information for specifying the server, together with the image, and wherein the transmitting device transmits the image to a server specified according to server identifying information recorded in the recording medium (column 8, lines 31-35).

17) Regarding claim 14, Ogawa teaches the mobile phone according to claim 12, wherein the recording medium records service content information indicating service content of the image, together with the image, and wherein the transmitting device

transmits service content information recorded in the recording medium to the server together with the image (column 8, line 66 – column 9, line 6; content information was incorporated into the image when converted and is therefore sent together with the image).

18) Regarding claim 15, Ogawa teaches the mobile phone according to claim 12, wherein the service information output device records the received service information in the recording medium and outputs the service information to the portable device via the recording medium (column 8, lines 13-27).

19) Regarding claim 16, Ogawa teaches the mobile phone according to claim 12, wherein the service information output device outputs the received service information to the portable device via one of a wireless communication device and a wired communication device (figure 1).

20) Regarding claim 20, Ogawa does not specifically teach the portable device according to claim 1, wherein said communication device comprises a mobile phone.

Endsley teaches the portable device according to claim 1, wherein said communication device comprises a mobile phone (column 2, lines 11-18; column 13, lines 22-29; the camera could be attached to a cell phone; alternatively the camera could communicate with a cellular device through a portable storage medium as shown in figure 1, item 20).

Ogawa and Endsley are combinable because they are both from the camera image field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Ogawa with Endsley to add a mobile phone. The motivation for doing so would have been "so that a separate communication device is not necessary" (column 13, line 25). Therefore it would have been obvious to combine Ogawa and Endsley to obtain the invention as specified by claim 20.

21) Claims 24-26 are rejected based on the same reasoning as previously stated in claims 12, 17, 18 and 23.

22) Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,603,506 by Ogawa et al. and further in view of U.S. patent 6,384,862 by Brusewitz et al.

Ogawa does not specifically teach the portable device according to claim 1, wherein when specification is made within a permissible range regarding an aspect ratio, the number of pixels, compressibility, or a file size that is included in the service information, the recording device automatically selects one of a maximum value and a minimum value within the permissible range, and records an image based on the selected service information in the recording medium.

Brusewitz teaches the portable device according to claim 1, wherein when specification is made within a permissible range regarding an aspect ratio, the number of pixels, compressibility, or a file size that is included in the service information, the recording device automatically selects one of a maximum value and a minimum value

within the permissible range, and records an image based on the selected service information in the recording medium (Column 6, lines 17-41).

Ogawa and Brusewitz are combinable because they are both from the image communication field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Ogawa with Brusewitz to add selecting a value in a permissible range. The motivation for doing so would have been because "the viewer may want different image resolution" (Column 5, lines 65-66). Therefore it would have been obvious to combine Ogawa with Brusewitz to obtain the invention as specified by claim 9.

23) Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,603,506 by Ogawa et al., and further in view of U.S. patent 6,307,591 by Yoshida et al.

Ogawa does not specifically teach the portable device according to claim 1, further comprising: an input device which allows a user to specify conditions of recording an image, the conditions including an aspect ratio of a predetermined image, the numbers of pixels in vertical and horizontal directions of an image, compressibility for compressing and recording an image, or a file size of an image upon recording, wherein when recording conditions specified by the user are within a permissible range of the corresponding service information inputted from said communication device, an

image based on the recording conditions specified by the user is recorded in the recording medium.

Yoshida teaches the portable device according to claim 1, further comprising: an input device which allows a user to specify conditions of recording an image, the conditions including an aspect ratio of a predetermined image, the numbers of pixels in vertical and horizontal directions of an image, compressibility for compressing and recording an image, or a file size of an image upon recording, wherein when recording conditions specified by the user are within a permissible range of the corresponding service information inputted from said communication device, an image based on the recording conditions specified by the user is recorded in the recording medium (Column 7, lines 1-6).

Ogawa and Yoshida are combinable because they are both from the camera-imaging field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Ogawa with Yoshida to add user specification of service information. The motivation for doing so would have been so that specifications are "selected by the user" (Column 7, line 3). Therefore it would have been obvious to combine Ogawa with Yoshida to obtain the invention as specified by claim 11.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 2625

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN O. DULANEY whose telephone number is (571)272-2874. The examiner can normally be reached on Monday - Friday (10am - 6pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin O Dulaney/

Examiner, Art Unit 2625

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625